

REMARKS

The following remarks are responsive to the Non-Final Office Action of February 4, 2009.

Claims 1–4, 6–21, 24, and 25 are currently pending in the application. These claims were rejected under 35 U.S.C. §103(a) as obvious over **Sugimoto** (U.S. Patent No. 6,829,009) in view of **Hong** (KR 2000-0030838) and **Stockton** et al. (U.S. Patent Application Publication No. 2002/0146250).

Applicant has amended claims 1, 12, and 20, and has canceled claims 8, 18, and 25.

35 U.S.C. §103(a), Claims 1–4, 6–21, 24, and 25 Obviousness over Sugimoto in view of Hong and Stockton

1. Applicant has amended independent claims 1, 12, and 20 to include the limitations of claims 8, 18, and 25 respectively. The combination of references fails to teach or suggest a reference number that is different for different operation modes.

In the Office Action, on pp. 2–15, the Examiner rejected claims 1–4, 6–21, 24, and 25 as being obvious over the teaching of Sugimoto in view of Hong and Stockton.

In response, Applicant has added the limitations of claims 8, 18, and 25 to independent claims 1, 12, and 20 respectively and discusses the distinction between the amended claims and the art cited against them below.

The amendments to the independent claims are directed to the feature that a different reference number (that serves as a basis for either updating the menu order (claim 1) or initially activating a menu item (claims 12 and 20))

With regard to previous claim 8, and now amended claim 1, the Examiner stated:

As per claim 8, and taking into account the rejection of claim 1, it would further be obvious that *the reference number and menu order may be different for different operation modes*. It would be obvious because Sugimoto and Hong would want their inventions to be applicable across all operating modes and not just one, as disclosed by the rejection of claim 1, *supra*.
[Emphasis in original]

Applicant respectfully disagrees with the asserted obviousness of a per-operation reference number based on the combined teaching of the references as well as the motivation to combine.

The Examiner cited both Hong and Sugimoto as disclosing aspects of the claimed reference number. The Examiner indicated that Hong discloses comparing a number of uses value to a reference number (Constitution, lines 1–4). Hong states, at the cited section.

In case that the number of the use times of the user is over the number of times set as a reference, the operation part(2) changes an initial setting menu to menus set by the user to be re-set.

The Examiner cited to Sugimoto at 8:30–35 as disclosing a reference value (“change frequency count”) that is examined in relation to frequency values. Sugimoto states:

At this time, the camera 10 should preferably be provided with a function for displaying the updated frequency order of the menu item 82 and the change count of each menu item together. The user can thus examine the display order of the menu items 82 with reference to the frequency order and the change frequency count.

With regard to the teaching of Sugimoto, the “change frequency count” is not any form of reference against which a number of changes is compared—it is only a count relating to the number of times a menu item has been selected and there is no form of comparison that is discussed. Figure 10, to which the quoted section pertains, simply illustrates decision blocks as to whether the use has decided whether a particular menu item should belong in the k^{th} position in the menu, and as to whether all menu items have been displayed (based on the number of items on the menu). No other form of comparison against a reference value are contemplated.

While Hong does seem to suggest some form of a reference number threshold, the disclosure only indicates a single reference number that is considered as a basis for any form of comparison.

The Examiner has cited Stockton for its disclosure of having different menus for different modes of operation. However, the relationship between an operation mode for displaying different menus as disclosed by Stockton and the use of differing reference numbers for different modes as required by the amended independent claims, particularly

given a complete lack of teaching related to operation modes in Sugimoto and Hong, is not something that can simply be inferred, absent a reliance on the description provided in the present specification, which is strictly prohibited as hindsight reasoning.

As for the motivation to apply the disclosure of Stockton to Sugimoto and Hong, the Examiner stated that it would be obvious that the reference number be different for different operation modes because Sugimoto and Hong would want their inventions to be applicable across all operating modes and not just one.

Even if *arguendo* the different operation modes disclosed by Stockton were combinable with Sugimoto and Hong, it does not follow that one would use different reference numbers across operation modes. One of ordinary skill in the art would initiate a menu reordering based on a common threshold across operation modes (in other words, the same number of user selections would be needed to trigger a menu reordering regardless of the operation mode), since this would be a simple and straightforward approach.

The independent claims, as amended, recognize that a user is more likely to spend more time making changes in a particular operation mode than another, and that it may be desirable for a threshold to be higher in order to trigger a change in such a mode of operation. Or, conversely, it can take into account the fact that some operation modes may be rarely used, but that a beneficial reordering of menu items could take place with a relatively few number of user selections that might be problematic or annoying in a different more frequently used operation mode.

In order to conclude obviousness, one has to not only make the questionable inference that one could easily adapt Stockton's different operation modes to the menu reordering of Sugimoto and Hong, but further would have to infer the desirability of adapting a frequency for triggering the reordering based on the particular operating mode that one is in. This is simply an aspect not taught by the combination of references, and not something that one of ordinary skill in the art, who would be seeking to minimize complexity and cost of the device, would arrive at unless such a beneficial outcome was recognized—which can only be derived from the teaching of the present specification.

The same logic applies to independent claims 12 and 20, even though these two claims deal with an activated menu item as related to the reference number. The remaining

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dependent claims are nonobvious over the combination of references by virtue of their dependence from the independent claims.

Based on the amendments to independent claims 1, 12, and 20, and arguments above, Applicant respectfully asserts that independent claims 1, 12, and 20, and the remaining claims that depend therefrom, are not obvious over the combination of Sugimoto, Hong, and Stockton and request that the 35 U.S.C. §103 rejection be withdrawn from the application.

Conclusion

For the foregoing reasons, all pending claims in the present application are believed to be allowable. Thus, the application is considered in good and proper form for allowance, and the Examiner is respectfully requested to pass this application to issue. If, in the opinion of the Examiner, a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned attorney.

Respectfully submitted,

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